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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/367,483	10/18/1999	TAKEO INAGAKI	IDE61601	4400

21118 7590 11/26/2002
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CANADA

EXAMINER

ZIMMER, MARC S

ART UNIT	PAPER NUMBER
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1712

17

DATE MAILED: 11/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

7C-17

Office Action Summary

Application No.

09/367,483

Applicant(s)

INAGAKI ET AL.

Examiner

Marc S. Zimmer

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-- Th MAILING DATE of this communication appears on th cover sheet with the correspondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 7-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 7-9 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file. The Examiner sincerely regrets his erroneous indication that this document was absent from the case

Specification

Applicant's amendments have not fully addressed the issues raised by the Examiner during the prosecution history of this case. Some of as-yet unresolved issues include:

(1) The Specification continues to disclose a compounding step as a means for adjusting the refractive index of a silicone gel. See, for instance, the paragraph bridging pages 4 and 5. Applicant has admitted that this description was improper and, insofar as mention of this step only makes the actual act of "adjusting" even less clear, should be entirely removed from the Specification.

(2) The amended paragraph at page 8, lines 7 to 11 still recites utilizes the term "binding region", which the Examiner has *repeatedly* objected to. All mention of a binding region should be replaced with language consistent with that employed in amended claim 1.

Furthermore, the amendment is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention.

(3) Applicant has, once again, substituted the word "additional" for "addition" in the paragraph bridging pages 7 and 8. This modification was made once before and

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subsequently objected to as introducing new matter. See the paragraph bridging pages 3 and 4 of paper no. 8 dated May 25, 2001.

(4) Applicant has also, for the second time, replaced "binding region" with "binding agent" at several, but not all, locations in the Specification. See the amended paragraph at page 8, lines 12-13 and the amended paragraph bridging pages 7 and 8. It is not clear whether this amendment was inadvertant or intended as Applicant did not submit a version showing changes made to the Specification (as they are required to do). This characterization was also previously objected to as only further convoluting the method. Please refer to the Examiner's comments in paper no. 8, pages 2 and 3.

Applicant is required to cancel the new matter in the reply to this Office Action. **Applicant is strongly encouraged to review the entire case history to ensure that any response to this Office action fully addresses all concerns raised throughout this prosecution. Applicant should be particularly diligent in fixing each and every instance of the objectionable subject matter.**

Claim Objections

Claim 7 is objected to because the phrase, "to that of said optical fires" appears twice consecutively. Hence, one occurrence of this phrase should be removed.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 1 and 7-9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is still not clear as to how said "adjustment" in claims 1 and 7 is achieved.

In Applicant's response filed August 27, 2002, they stated that the Examiner's *assumption* that the adjusting step merely refers to a process wherein a polymer is judiciously selected based on its desired properties is correct. However, the Examiner made no such assumption. In paper no. 12, it was questioned whether the refractive index was controlled by controlling the number of aryl substituents on the polymer backbone as *Filas* and *Suzuki* had done. At the same time, the Examiner stated that, if this was indeed how the Applicants were supposed to have achieved an "adjustment" in the refractive index of the polymer, there was no support for this concept. See the bottom of the first paragraph in page 4. Mere selection of a silicone base polymer having a specified refractive index is unsupported leaving the "adjustment" step undefined.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 7-9 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has still not addressed the Examiner's concerns that the term "low" is ambiguous.

Claim 1 is further rejected because it still contains the second mention of a compounding step. Antecedent basis for "said compounding step" no longer exists.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 703-605-1176. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

November 22, 2002

A handwritten signature in black ink, reading "Margaret G. Moore". The signature is written in a cursive style with a large, flowing "M" and "G".

MARGARET G. MOORE
PRIMARY PATENT EXAMINER
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